

Appl. No. 09/821,965
Amendment and/or Response
Reply to Office action of 3 October 2003

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REMARKS / DISCUSSION OF ISSUES

Claims 1-22 are pending in the application.

The Examiner is respectfully requested to state whether the drawings are acceptable.

Claims 1, 9, 13, and 18 are amended for non-statutory reasons. Claims 1 and 9 are amended to replace the original claim phraseology and structure with more conventional claim language. Claim 13 is amended to correct a typographical error, and claim 18 is amended to conform to the rewording of claim 9. The claims are not narrowed in scope and no new matter is added.

The Office action rejects claims 1-22 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Applicant respectfully traverses this rejection in view of amended claims 1 and 9.

In the interest of advancing prosecution in this case, claims 1 and 9 are amended herein to employ conventional claim language and structure to describe a method of providing software and/or content information. The Applicant respectfully maintains that claims 1 and 9 are each within the technical arts and each provide new, useful, concrete, and tangible result, and respectfully requests the Examiner's reconsideration of the rejection of claims 1-22 under 35 U.S.C. 101.

The Office action rejects claims 1-22 under 35 U.S.C. 102(e) as being anticipated by Jacobs et al. (USPA 2001/0034763, hereinafter Jacobs). The Applicants respectfully traverse this rejection.

The Examiner's attention is requested to MPEP 2131, wherein it is stated: "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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Independent claims 1 and 9 specifically recite methods wherein a request for a content information triggers a transfer of a software element for rendering the requested content information, and effects a compensation to the provider of the software element.

Jacobs discloses a playlist server program that provides for the sequential presentation of advertisements from a playlist of advertisements in an e-mail application. The Applicant is unable to detect any correlation between Jacobs and the Applicant's claimed invention.

For example, the Office action refers to Figure 9 of Jacobs for teaching the Applicant's invention, whereas Jacobs describes Figure 9 as illustrating "an exemplary state flow diagram of a process by which the Paid User becomes an Unpaid user". The Applicant respectfully maintains that reclassifying an e-mail user as an unpaid user is totally irrelevant to the Applicant's claims.

The Office action further cites paragraphs 0011, 0012, 0013, and 0042, as teaching the Applicant's claimed invention. Paragraph 0011 describes QUALCOMM's e-mail product offerings, EUDORA Pro and EUDORA Lite. Paragraph 0012 describes QUALCOMM's newer e-mail product, EUDORA Adware. Paragraph 0013 describes the typical fee schedules of Internet Service Providers. Paragraph 0042 states: "FIG. 11 illustrates a Nag Schedule employed by the software according to the present invention". The Applicant again respectfully maintains that a description of e-mail product offerings, fee schedules of ISPs, and a "Nag" program are totally irrelevant to the Applicant's claims.

The Office action provides no further insight regarding how the referenced figure and paragraphs are thought to correspond to the Applicant's claimed invention.

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In view of the foregoing, the Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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